

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Burgin, et al. : Atty. Ref: 1160215-0531072

Serial No. 09/944,836 : Group Art Unit: 2179

Filed: August 31, 2001 : Examiner: Mylinh Tran

For: **SYSTEM AND METHOD FOR AUTOMATED END USER SUPPORT**

**ARGUMENTS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In accordance with 1296 Off. Gaz. Pat. Office 67 (July 12, 2005)

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Dear Sir:

The Final Office Action dated August 24, 2006 ("Final Office Action") rejected claims 1-7, 9-20, 22-25, 27 and 28 as obvious over U.S. 2004/0088345 ("Zellner") in view of U.S. 6,658,464 ("Reisman"). However, at least one essential element needed for a prima facie case of obviousness was absent from the rejection of each independent claim, claims 1, 13, 20, and 25. Additionally, the Final Office Action did not address each limitation recited in the pending dependent claims. Therefore, applicants request that the panel withdraw the Final Office Action's rejections, and either re-open prosecution on the merits or allow the pending claims. The concise arguments for which review is requested are set forth below.

Claim 1

The Final Office Action's rejection of claim 1 is a result of a clear legal error because it is based on a reference which is not analogous to the applicants' invention. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned."¹ The present claims are in the field of automated end user support systems,² and are particularly directed to addressing the

¹ MPEP § 2141.01(a) citing *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

² U.S. Application 09/944,836, ¶ 3.

problem of poor customer experiences using ecommerce web sites.³ By contrast, Zellner is in the field of “emergency reporting services,”⁴ and its subject matter is directed to “offer[ing] an emergency reporting device that is capable of reporting a user’s need for emergency help using TCP/IP message packets sent over the Internet to the ESC 12...[and] a subscription-based or usage-based emergency reporting service using TCP/IP messaging over the Internet.”⁵ These are not reasonably analogous fields of subject matters for at least the reason that automated end user support is used to minimize the necessity for human beings to be involved in an interaction,⁶ while TCP/IP based emergency reporting services are used to ensure that a human is involved in an interaction as fast as possible.⁷

Further, to the extent that Zellner is considered analogous to the present invention, the Final Office Action did not show a proper motivation to modify Zellner with the teachings of Reisman in making the obviousness rejection of claim 1. When a claim is rejected as obvious, the reference cited must be modified to meet that claim.⁸ The Examiner has the responsibility of showing that the prior art provides some motivation to make that modification.⁹ That showing must include actual evidence of a suggestion, teaching or motivation to combine prior art references.¹⁰ In rejecting claim 1, the Examiner conceded that Zellner does not teach or suggest encoding a present navigation link so that it appears to be associated with a second domain associated with a support location remote relative to the end user, limitations which are recited in the fourth and fifth clauses of claim 1. The Examiner then stated that Reisman teaches those limitations, and that “Motivation [for one of ordinary skill in the art at the time of the invention to combine Reisman and Zellner] would have been to provide the end user with an interactive and intelligent support session.”¹¹ However, the Examiner did not identify *any* evidence in support of the statement regarding motivation to combine. This is a clear error of law, as the Federal Circuit has explicitly stated that “[b]road conclusory statements regarding the teaching of references, standing alone, simply *are not evidence.*”¹² If this were not the case, then it would be possible to reject an invention as obvious by using “the claimed invention itself as a blueprint for piecing

³ U.S. Application 09/944,836, ¶ 4.

⁴ Zellner, ¶ 4.

⁵ Zellner, ¶ 12.

⁶ U.S. Application 09/944,836, ¶¶ 5-6.

⁷ For example, Zellner, ¶ 62, teaches commencing relief efforts by dispatching medical workers and firefighters.

⁸ MPEP § 706.02(IV)

⁹ MPEP § 2142.

¹⁰ *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

¹¹ Final Office Action mailed 8/24/06 at 4.

¹² *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (emphasis added).

together elements in the prior art to defeat the patentability of the claimed invention.”¹³ Therefore, the rejection of claim 1 is clearly insufficient for at least the following reasons:

- 1) The Final Office Action based its obviousness rejection of claim 1 on a reference which is neither in the field of applicants’ endeavor, nor pertinent to the problem with which the applicants were concerned; and
- 2) The Final Office Action’s asserted motivation to combine the teachings of Zellner and Reisman consisted of an unsupported conclusory statement and was not accompanied by the actual evidence necessary to make out a *prima facie* case of obviousness.

Claim 13

The Final Office Action did not show that the combination of Zellner and Reisman taught or suggested “an annotation server” as is recited in the fourth and fifth clauses of claim 13. A requirement for a *prima facie* case of obviousness is that all claim limitations must be taught or suggested by the prior art.¹⁴ In response to a previous office action, applicants specifically highlighted the limitations of the fourth and fifth clauses of claim 13 dealing with an annotation server as not being taught or suggested in the prior art.¹⁵ However, rather than showing that either Zellner or Reisman teach or suggest an “annotation server,” the Final Office Action simply rejected claim 13 in a group with claims 1, 19, 20 and 25, none of which include an “annotation server” as recited in claim 13. Additionally, because the Final Office Action combined its treatment of claims 1 and 13, the rejection of claim 13 suffers from the same infirmities set forth above regarding claim 1. Therefore, the rejection of claim 13 based on the combination of Zellner and Reisman is clearly insufficient for at least the following reasons:

- 1) The Final Office Action did not make out a *prima facie* case of obviousness because it did not address the “annotation server” as recited in the fourth and fifth clauses of claim 13; and
- 2) The weaknesses of the rejection of claim 1 – that Zellner is non-analogous art relative to the applicants’ invention and that the Final Office Action provided no evidence of a motivation to modify the prior art – apply equally to claim 13 because the Final Office Action’s treatment of claim 13 was combined with its treatment of claim 1.

¹³ *In re Rouffet* 47 USPQ2d 1453, 1457 (Fed. Cir. 1998).

¹⁴ MPEP § 2143.03, ¶ 1 citing *In re Royka*, 490 F.2d 981 (CCPA 1974).

¹⁵ See Response to Office Action mailed 12/15/2005, page 3.

Claims 20 and 25

The weaknesses set forth above regarding the rejection of claim 1 apply equally to claims 20 and 25. As noted previously, the Final Office Action combined its treatment of claims 1, 13, 19, 20 and 25. Therefore, the rejections of claims 20 and 25 are clearly insufficient for at least the reasons set forth above regarding claim 1.

Claims 6, 9, 10, and 16

The Final Office Action simply did not address several limitations recited in the pending dependent claims. For example, dependent claim 6 recites the limitations of “wherein the content corresponding to the decoded embedded navigation link is received from the content location,” but those limitations were simply not mentioned in the Final Office Action’s treatment of that claim.¹⁶ The Final Office Action similarly did not address the limitations of “wherein the embedded navigation link is associated with a first transport protocol and the end-user support is associated with a second transport protocol” from claim 9,¹⁷ of “wherein the embedded navigation link is a first embedded navigation link and wherein the first navigation link is associated with the first domain and wherein the retrieved content includes a second navigation link associated with the second domain” from claim 10,¹⁸ and of “a skills module in communication with the roles module,” from claim 16.¹⁹ Additionally, applicants note that, as set forth above, the Final Office Action did not make out a *prima facie* case of obviousness for any of the independent claims in the application, and therefore that, simply by virtue of their dependency, each dependent claim is also non-obvious.²⁰ Therefore, the rejections of claims 6, 9, 10 and 16 are clearly insufficient for at least the following reasons:

- 1) The Final Office Action’s rejections of claims 6, 9, 10 and 16 simply did not address certain limitations recited in those claims; and
- 2) Because of their dependent status, claims 6, 9, 10 and 16 are patentable for at least the reasons set forth above regarding their respective independent claims.

¹⁶ See Final Office Action, page 6.

¹⁷ See Final Office Action, page 6.

¹⁸ See Final Office Action, page 7.

¹⁹ See Final Office Action, page 8.

²⁰ MPEP § 2143.03 (“If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.” quoting *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Conclusion

For at least the reasons above, it is respectfully submitted that the rejections of the pending claims as obvious over Zellner in view of Reisman are clearly insufficient. Therefore, the applicants request that the panel withdraw those rejections and either allow the pending claims in their current form or re-open prosecution on the merits.

The applicants note that due to the length and content restrictions of the pre-appeal review program, this paper does not include all arguments related to the pending claims. To the extent that applicants have not addressed certain aspects of the present rejection, please do not construe the same as an admission as to the merits of the rejections. Indeed, applicants reserve all rights with respect to arguments not explicitly raised herein.

The Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully submitted,

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